REMARKS/ARGUMENTS

This Amendment is being filed in response to the first Official Action of February 3, 2009 on a second Request for Continued Examination (RCE). Initially, Applicant would like to thank the Examiner for taking the time to conduct a telephone interview with Applicants' undersigned attorney regarding the first Official Action. Claims 1, 5, 10, 14, 19, 22-28, 32 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,810 to Geiger et al., in view of U.S. Patent Application Publication No. 2004/0093502 to Shurygailo et al. Claims 3, 12, 20 and 30 stand rejected as being unpatentable over Geiger in view of Shurygailo, and further in view of U.S. Patent No. 6,377,810 to Ganesh; Claims 4, 6, 8, 9, 13, 15, 17, 18, 21 and 31 stand rejected as being unpatentable over Geiger in view of Shurygailo, and further in view of U.S. Patent Application Publication No. 2004/0064707 to McCann et al.; Claims 7 and 16 stand rejected as being unpatentable over Geiger in view of Shurygailo, and further in view of U.S. Patent Application Publication No. 2002/0083183 to Pujare et al.; and Claims 34-36 stand rejected as being unpatentable over Geiger in view of Shurygailo, and further in view of U.S. Patent No. 7,240,015 to Karmouch et al.

As explained below, Applicant respectfully submits that the claimed invention is patentably distinct from Geiger, Shurygailo, Ganesh, McCann, Pujare and Karmouch, taken individually or in any proper combination. Nonetheless, Applicant has amended various ones of the claims to further clarify the claimed invention. In view of the amendments to the claims and the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application.

A. *Substance of Examiner Interview*

During the Examiner interview, the Examiner and Applicant's representative discussed the rejection of the claims under § 103 as being unpatentable over Geiger in view of Surygailo, alone or further in view of one or more of Ganesh, McCann, Pujare or Karmouch. More particularly, the Examiner clarified for Applicant's as to how the Examiner reads Surygailo on at least independent Claims 1, 10, 19 and 28. The Examiner and Applicant did not reach agreement.

B. Claim Construction and Prima Facie Anticipation/Obviousness

Initially, Applicant notes that the Patent Office has the initial burden of proof in establishing *prima facie* anticipation or obviousness of a claimed invention under 35 U.S.C. § 102 or § 103. *In re Warner*, 379 F.3d 1011, 1016 (CCPA 1967). To make a fair review of the merits of a *prima facie* case of anticipation or obviousness, "[t]he Examiner must make specific findings as to claim construction." *Ex parte* Beery, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte* Blankenstein et al., Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07.

In the Official Action, the Office has failed to provide Applicant with a sufficient claim construction or interpretation of the cited references so as to enable the Applicant to make a fair review of the merits of the case of anticipation or obviousness proffered by the Examiner, or to effectively reply. Other than quoting or paraphrasing Applicant's claim language with annotated citations to figures, or column and line numbers of the cited references, the Examiner provides no finding or other explanation regarding Applicant's claims, the cited references, or the application of the cited references to Applicant's claims. The Board of Patent Appeals has found that the mere citing of passages of the prior art is insufficient to meet the Examiner's "initial burden of pointing out where the applied prior art teaches or suggests Appellant's invention." *Ex parte* Beery, Appeal No. 2008-0543, page 5. As stated by the Board in *Ex parte* Beery, "The difficulty we have with the Examiner's position is its failure to specifically point out where in the cited passages there is found a teaching of each of the disputed claim limitations." *Id.*

Applicant therefore respectfully submits that the Examiner has failed to establish *prima facie* anticipation or obviousness of the claimed invention. Should the Examiner continue to reject the claims as being unpatentable over the same or any other ground, Applicant respectfully requests that the Examiner submit on the record specific findings as to the construction being applied to the claims, an explanation of the references being cited against the claims, and how those references disclose recited features of the claims.

C.   Claims 1, 5, 10, 14, 19, 22-28, 32 and 33 are Patentable

Claims 1, 5, 10, 14, 19, 22-28, 32 and 33 stand rejected as being unpatentable over Geiger, in view of Shurygailo. As previously explained, in contrast to independent Claim 10, Geiger does not teach or suggest controlling access to an event whereby the entity controlling access to event-based information (first network entity) receives a request to access that information from another entity (second network entity) unknown to the first network entity prior to receiving the request. More particularly, Geiger does not teach or suggest controlling access to an event whereby the entity controlling access to event-based information (first network entity) may receive consent and may create an authorization without use of a certificate from the requesting entity (second network entity), and without verifying an identity of the requesting entity.

The Official Action appears to concede that Geiger fails to teach or suggest the aforementioned feature, but alleges that Shurygailo discloses the feature, and that it would have been obvious to one skilled in the art to combine Geiger and Shurygailo to teach the system of independent Claim 10. Applicant respectfully disagrees, however, and submits that not only does Shurygailo also fail to teach or suggest the aforementioned feature, but that there does not exist an apparent reason to modify Geiger per Shurygailo, as alleged.

1.   Shurygailo, like Geiger, fails to Disclose Consent and Automatic Authorization-Creation

As indicated above, like Geiger, <u>Shurygailo also fails to teach or suggest controlling access to an event whereby an access-controlling entity (first network entity) receives a request for access-controlled information from another, unknown entity (second network entity), and may receive consent and create an authorization without use of a certificate from the requesting entity (second network entity), and without verifying an identity of the requesting entity,</u> as per independent Claim 10. The Official Action cites paragraph [0027] of Shurygailo for allegedly disclosing the aforementioned feature.

Briefly, Shurygailo discloses a system including an originator that requests and receives, from a system, a token for accessing an entitlement available from the system. The originator

may then pass the token to a target user who can then access the entitlement from the system –
and may do so without first registering with the system.

a)   *Examiner's Interpretation of Shurygailo*

During the aforementioned interview with the Examiner, the Examiner asserted that the
system of Shurygailo corresponds to the recited first network entity, and that the target user
corresponds to the recited second network entity. According to the Examiner, Shurygailo
discloses that the system receives a request for a token from the target user via the originator, and
replies with the token back to the target user (presumably again via the originator). And as per
Shurygailo, the target user is unknown to the system before the system receives the request.
Applicant respectfully disagrees with this interpretation.

First, contrary to the interpretation proffered by the Examiner, nowhere does Shurygailo
explicitly or inherently teach or suggest that the target user requests the token from the system
via the originator. In fact, nowhere does Shurygailo explicitly or inherently disclose that the
target user requests a token from the originator. Shurygailo is actually silent as to what if
anything prompts the originator to request the token.

Second, even if one could argue that the target user requests the token via the originator,
Shurygailo does not explicitly or inherently disclose that any request from the target user is what
is received by the system. Shurygailo clearly implies if not explicitly states that although the
target user need not be registered with the system, the originator is registered with the system.
See Shurygailo, at least paragraph [0029]. Clearly, then, if the system is to grant a token to an
entitlement, Shurygailo would grant that token in response to a request from the originator, and
not from the target user. And even if that request is prompted by a request from the target user,
the request to the system (from the originator with the entitlement) still cannot be said to
correspond to the request from the target user.

b)   *Alternative Interpretation of Shurygailo*

Under an alternative (and arguably more proper) interpretation of Shurygailo, one might
argue that the originator corresponds to a first network entity, that the target user corresponds to

a second network entity, and that the system corresponds to an event server. This interpretation is graphically illustrated below. Under this interpretation, again, Shurygailo does not teach or suggest that its originator receives a request from the target user to access an entitlement or other information. Shurygailo does not teach or suggest that its originator creates an authorization – instead the authorization is created by the system (in response to an originator request). Finally, Shurygailo does not teach or suggest that its target user is unknown to the originator before receiving any request from the originator. Instead, Shurygailo discloses that its target user may be unknown to the system.
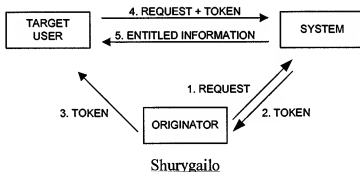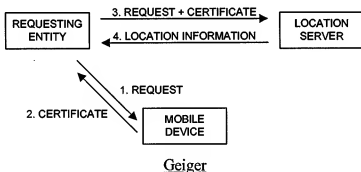

Shurygailo

For at least the foregoing reasons, Applicant therefore submits that neither Geiger nor Shurygailo teaches or suggests the system of independent Claim 10.

2. *Combination Does Not Teach or Suggest*

Not only do Geiger and Shurygailo fail to teach or suggest the system of independent Claim 10, Applicant respectfully submits that the combination also fails to teach or suggest independent Claim 10. That is, even the combination of Geiger and Shurygailo does not teach or suggest an access-controlling entity (first network entity) receives a request for access-controlled information from another, unknown entity (second network entity), and may receive consent and create an authorization without use of a certificate from the requesting entity (second network entity), and without verifying an identity of the requesting entity.

For comparison purposes, consider the above graphical illustration of Geiger. From this illustration and the above illustration of Shurygailo, one might argue that the modification of Geiger per Shurygailo permits a requesting entity (second network entity) to request and receive location information from a location server (event server) with which the requesting entity is unknown (or not registered with) beforehand. Even given this modification, however, the combination still fails to teach or suggest that the requesting entity (second network entity) is unknown to the mobile device (first network entity) prior to the mobile device receiving a request from the requesting entity, similar to the system of independent Claim 10 reciting that the second network entity is unknown to the first network entity beforehand. And again, the second network entity being unknown may be reflected by the first network entity creating the authorization without use of a certificate from the second network entity and without verifying an identity of the second network entity.

Geiger

Applicant therefore respectfully submits that independent Claim 10, and by dependency Claims 12-18, 23, 26 and 34, is patentably distinct from Geiger and Shurygailo, taken individually or in any proper combination. Applicant also respectfully submits that independent Claims 1, 19 and 28 recite subject matter similar to that of independent Claim 10, including the aforementioned consent and automatic authorization-creation features with receipt of a request from a network entity unknown prior to the request, and without a certificate of the requesting entity and without verifying the requesting entity's identity. As such, Applicant also respectfully submits that independent Claims 1, 19 and 28, and by dependency Claims 3-9, 20-22, 24, 25, 27,

30-33, 35 and 36, are also patentably distinct from Geiger and Shurygailo, taken individually or in any proper combination, for at least the reasons given above.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of Claims 1, 5, 10, 14, 19, 22-28, 32 and 33 as being unpatentable over Geiger, in view of Shurygailo is overcome.

C.   Claims 3, 12, 20 and 30 are Patentable

The Official Action rejects Claims 3, 12, 20 and 30 as being unpatentable over Geiger in view of Shurygailo, and further in view of Ganesh. As explained above, independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger and Shurygailo, taken individually or in any proper combination. Applicant respectfully submits that Ganesh does not cure the deficiencies of Geiger and Shurygailo. That is, even considering Ganesh, none of Geiger, Shurygailo or Ganesh, taken individually or in any proper combination, teaches or suggests the aforementioned consent and automatic authorization-creation features with receipt of a request from a network entity unknown prior to the request, and without a certificate of the requesting entity and without verifying the requesting entity's identity, as per independent Claims 1, 10, 19 and 28. Applicants therefore respectfully submit that independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger, Shurygailo and Ganesh, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 3, 12, 20 and 30 as being unpatentable over Geiger in view of Shurygailo, and further in view of Ganesh is overcome.

D.   Claims 4, 6, 8, 9, 13, 15, 17, 18, 21 and 31 are Patentable

The Official Action rejects Claims 4, 6, 8, 9, 13, 15, 17, 18, 21 and 31 as being unpatentable over Geiger in view of Shurygailo, and further in view of McCann. As explained above, independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger and Shurygailo, taken individually or in any proper

combination. Applicant respectfully submits that McCann does not cure the deficiencies of Geiger and Shurygailo. That is, even considering McCann, none of Geiger, Shurygailo or McCann, taken individually or in any proper combination, teach or suggest the aforementioned consent and automatic authorization-creation features with receipt of a request from a network entity unknown prior to the request, and without a certificate of the requesting entity and without verifying the requesting entity's identity, as per independent Claims 1, 10, 19 and 28. Applicants therefore respectfully submit that independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger, Shurygailo and McCann, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 4, 6, 8, 9, 13, 15, 17, 18, 21 and 31 as being unpatentable over Geiger in view of Shurygailo, and further in view of McCann is overcome.

E. Claims 7 and 16 are Patentable

The Official Action rejects Claims 7 and 16 as being unpatentable over Geiger in view of Shurygailo, and further in view of Pujare. As explained above, independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger and Shurygailo, taken individually or in any proper combination. Applicant respectfully submits that Pujare does not cure the deficiencies of Geiger and Shurygailo. That is, even considering Pujare, none of Geiger, Shurygailo or Pujare, taken individually or in any proper combination, teach or suggest the aforementioned consent and automatic authorization-creation features with receipt of a request from a network entity unknown prior to the request, and without a certificate of the requesting entity and without verifying the requesting entity's identity, as per independent Claims 1, 10, 19 and 28. Applicants therefore respectfully submit that independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger, Shurygailo and Pujare, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 7 and 16 as being unpatentable over Geiger in view of Shurygailo, and further in view of Pujare is overcome.

F.   *Claims 34-36 are Patentable*

The Official Action rejects Claims 34-36 as being unpatentable over Geiger in view of Shurygailo, and further in view of Karmouch. As explained above, independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger and Shurygailo, taken individually or in any proper combination. Applicant respectfully submits that Karmouch does not cure the deficiencies of Geiger and Shurygailo. That is, even considering Karmouch, none of Geiger, Shurygailo or Karmouch, taken individually or in any proper combination, teach or suggest the aforementioned consent and automatic authorization-creation features with receipt of a request from a network entity unknown prior to the request, and without a certificate of the requesting entity and without verifying the requesting entity's identity, as per independent Claims 1, 10, 19 and 28. Applicants therefore respectfully submit that independent Claims 1, 10, 19 and 28, and by dependency Claims 3-9, 12-18, 20-27 and 30-36, are patentably distinct from Geiger, Shurygailo and Karmouch, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 34-36 as being unpatentable over Geiger in view of Shurygailo, and further in view of Karmouch is overcome.

CONCLUSION

In view of the amendments to the claims and the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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